SEP 2 2 2003

No. 03-124

IN THE

Supreme Court of the United States

MOBA, B.V., STAALKAT, B.V., and
FPS FOOD PROCESSING SYSTEMS, INC.,

Petitioners,

v.

DIAMOND AUTOMATION, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

ALBERT J. BRENEISEN
Counsel of Record
JOHN W. BATEMAN
SHEILA MORTAZAVI
KENYON & KENYON
Attorneys for Respondent
One Broadway
New York, NY 10004
(212) 425-7200

183183

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

QUESTION PRESENTED

Should the Federal Circuit decision upholding validity of the patent, while reversing the jury's finding of non-infringement because it misapplied the facts, be vacated when the Federal Circuit did *not* change the district court's claim interpretation given to the jury?

STATEMENT PURSUANT TO RULE 29.6

Respondent Diamond Automation, Inc. is a privately owned company. No parent or publicly held company owns 10% or more of the corporation's stock.

TABLE OF CONTENTS

	Page
Question Presented	i
Statement Pursuant to Rule 29.6	ii
Table of Contents	iii
Table of Cited Authorities	v
Counter-Statement of the Case	2
A. The Appeal Before the Federal Circuit Neither Invited Nor Caused a Change in Claim Interpretation	2
B. Proceedings Below	3
1. The District Court's Claim Construction	3
2. Trial	5
3. Post-Trial Motions and Diamond's Appeal of the District Court's Denial of Its JMOL Motion	8
4. The Federal Circuit's Decision	9
Reasons for Denying the Petition	11

Contents

Page

A. The Decision Below Does Not Create a Conflict Warranting Certiorari 11

1. The Federal Circuit Did Not Alter the Claim Interpretation on Appeal and Consequently its Decision Cannot in Any Way Be Characterized as Impacting Petitioners' Right to a Jury Trial 12

2. FPS Has Not Identified Any Errors in the Jury Instructions Warranting a New Trial 14

B. The Federal Circuit Applied The Correct Standard of Review With Respect to Both The Infringement And The Validity Issues 15

Conclusion 18

TABLE OF CITED AUTHORITIES

Cases: *Page*

Al-Site Corp. v. VSI Int'l, Inc.,
174 F.3d 1308 (Fed. Cir.1999) 13

Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.,
320 F.3d 1339 (Fed. Cir. 2003) 13

C.R. Bard, Inc. v. M3 Sys., Inc.,
157 F.3d 1340 (Fed. Cir. 1998) 13

Door-Master Corp. v. Yorktowne, Inc.,
256 F.3d 1308 (Fed. Cir. 2001) 17

Eaton Corp. v. Rockwell Int'l Corp.,
323 F.3d 1332 (Fed. Cir. 2003) 13, 16

Ecolab Inc. v. Paraclipse, Inc.,
285 F.3d 1362 (Fed. Cir. 2002) 13, 14, 15

Key Pharms. v. Hercon Labs. Corp.,
161 F.3d 709 (Fed. Cir. 1998) 13

LaPorte Pigments, Inc. v. Axel J., LP,
2002 WL 1890749 (Fed. Cir. Aug. 15, 2002) ... 13

Mitsubishi Elec. Corp. v. Ampex Corp.,
190 F.3d 1300 (Fed. Cir. 1999) 17

Cited Authorities

Page

PIN/NIP, Inc. v. Platte Chem. Co.,
304 F.3d 1235 (Fed. Cir. 2002) 17

Teleflex, Inc. v. Ficosa N. Am. Corp.,
299 F.3d 1313 (Fed. Cir. 2002) 13, 15, 17

Texas Digital Sys., Inc. v. Telegenix, Inc.,
308 F.3d 1193 (Fed. Cir. 2002) 13

Union Carbide Chems. & Plastics Tech. v. Shell Oil Co.,
308 F.3d 1167 (Fed. Cir. 2002) 9, 13, 16

Respondent Diamond Automation, Inc. ("Diamond") requests that this Court deny the petition for writ of certiorari filed by Petitioners Moba B.V., Staalkat B.V., and FPS Food Processing Systems, Inc. (collectively, "FPS" or "Petitioners"). Contrary to Petitioners' assertions, this case does not present any issues regarding Petitioners' right to a jury trial with respect to validity issues; Petitioners have already had such a trial based on correct claim interpretation, which resulted in an unfavorable jury verdict for them, and now merely seek to have a second chance to challenge the validity of the patent-in-suit.[1] Importantly, this is not a case in which the Federal Circuit changed the district court's claim interpretation on appeal; on the contrary, with respect to the claim at issue, the Federal Circuit affirmed the claim interpretation given to the jury by the district court. The Federal Circuit only rejected the district court's erroneous attempt to sustain a non-infringement finding not supported by the evidence through a post-verdict change to its originally correct claim interpretation. That in no way implicates the Petitioners' right to a jury trial with respect to validity. Indeed, once FPS's false premise of a changed claim interpretation on appeal is stripped away, none of FPS's arguments are sustainable.

---

1. Diamond asserted four patents during trial — U.S. Patent No. 4,569,444, U.S. Patent No. 4,505,373, U.S. Patent No. 4,519,494, and U.S. Patent No. 4,519,505. Although Diamond believed that all four patents are infringed, Diamond only appealed the non-infringement findings with respect to the '494 patent and the '505 patent, in order to both simplify and fully explicate the issues before the United States Court of Appeals for the Federal Circuit. Given the Federal Circuit's decision, the only patent currently at issue is the '505 patent. Accordingly, in this Opposition, Diamond has limited its statements and arguments to only those issues pertaining to the '505 patent.

COUNTER-STATEMENT OF THE CASE

A. The Appeal Before the Federal Circuit Neither Invited Nor Caused a Change in Claim Interpretation

In its petition, FPS makes numerous incorrect references to the Federal Circuit changing the district court's claim interpretation on appeal. That simply did not occur in this case.

The appeal at issue concerned the district court's denial of Diamond's motion for judgment as a matter of law ("JMOL"); it did not involve any error in jury instructions with respect to claim interpretation. The basis of Diamond's appeal to the Federal Circuit was that the original claim construction issued by the court and given to the jury must be upheld, and that the district court's post-verdict changes to that claim interpretation must be rejected. While FPS incorrectly states that the Federal Circuit broadened the claim interpretation on appeal, the Federal Circuit clearly understood the procedural posture of the case before it:

> Diamond does not now contest the district court's instruction to the jury on the meaning of "guiding steps." Essentially ***Diamond does not wish to alter the district court's claim construction on appeal, but seeks enforcement of the trial court's claim construction.***

(Pet. App. 11a) (emphasis added). In rendering its decision, the Federal Circuit did exactly as Diamond had asked — it upheld the district court's original and binding claim construction order. It did not broaden that claim construction.

B. Proceedings Below

Diamond is a Michigan corporation that manufactures and sells high speed egg processing machinery to sort batches of eggs into different categories by weight and quality. In the early 80s, Diamond developed technology that significantly increased the processing speed for egg grading machinery and obtained various patents covering that technology, including U.S. Patent No. 4,519,505 ("the '505 patent").

It was Diamond that first sued FPS in the Eastern District of Michigan in 1994, alleging that FPS's activities involving the Moba Omnia and Staalkat Selecta egg processing machines infringe various claims of Diamond's patents, including claim 24 of the '505 Patent. After a personal jurisdiction issue was raised in that case, FPS sued Diamond in the Eastern District of Pennsylvania in 1995, alleging that Diamond's patents are invalid and not infringed. Diamond filed a counterclaim for a declaratory judgment on the same issues.

1. The District Court's Claim Construction

After discovery, the district court held a two-day *Markman* hearing. In March 1999, the Court issued a *Markman* Order and a Memorandum explaining its rulings on the many claim interpretation issues raised at the hearing. In its Order, the Court interpreted, *inter alia*, the limitations in dispute with respect to claim 24 of the '505 patent. The Court first interpreted "holding station" to mean "a first location in space to which an egg is moved and at which the egg may maintain position until the egg is lifted simultaneously with an egg at a 'spaced-apart location'",

and further defined a "spaced -apart location" as "a second location downstream from and substantially horizontally coplanar with the 'holding station.'" (Pet. App. 111a.) FPS made no objection to the district court's interpretation of these limitations. The Court then interpreted the "guiding steps" limitation of claim 24 to mean:

1. "Carrying eggs to holding stations;"

2. "Carrying eggs from the holding stations to the spaced apart locations;" and

3. "Carrying more eggs to the holding stations."

(Pet. App. 112a.) In its Memorandum explaining its claim interpretation, the Court explained why it disagreed with the position that FPS had advanced with respect to the "guiding steps" limitation:

> [FPS] request[s] the Court to find specifically that the travel of eggs between the "holding stations" and the "spaced-apart locations" is not via conveyor belt or other physically connected pathway but rather by "picking and placing." The Court declines to impose a "lifting" or "picking an placing" requirement on claim 24.

(Pet. App. 101a.) The Court's original claim interpretation, therefore, was broader than that urged by FPS, and did not exclude a method wherein the second and third steps occurred simultaneously. FPS did not object to the court's interpretation of this limitation either.

2. Trial

Trial was held between January 28, 2000 and February 25, 2000. Undeterred by the unfavorable claim construction with respect to the "guiding steps" limitation of claim 24, and without objecting to that broader and binding claim construction, FPS chose to re-package its 'picking and placing' argument at trial and argue to the jury that the Omnia does not infringe because it performs two of the three steps simultaneously rather than in three separate steps. FPS also made erroneous arguments with respect to the "holding station" limitation, arguing that the district court's order required that an egg cease motion before it is lifted into the overhead conveyor. Similarly, with respect to validity, FPS continuously urged the jury to adopt its interpretation of the disputed terms, despite the obvious inconsistencies between its proposed interpretations and the district court's claim interpretation order.

Diamond pointed out during trial that the interpretations of the disputed limitations that FPS was presenting to the jury were contrary to the intrinsic evidence, and were nothing more than a disguised version of the arguments that had already been rejected by the court. Diamond argued that the evidence FPS was relying on to show non-infringement should be disregarded since it was all based on erroneous claim interpretation, and that judgment as a matter of law ("JMOL") in Diamond's favor on the infringement issues was therefore appropriate. The court never addressed or resolved these issues, however, before the jury deliberations began.

Notably, the only instruction that the jury received was the court's original and proper interpretation of the claim,

which was upheld on appeal.[2] The jury cannot be presumed to have made the same mistake with respect to the court's claim construction that FPS did, particularly since the jury was properly instructed by the court regarding the correct interpretation of "guiding steps," as it was properly instructed with respect to the other limitations of claim 24.

While FPS attempts to support its petition by conjecture as to what the jury might have been thinking when it reached its decision, its hypotheses as to the jury's deliberations cannot be taken as fact. FPS cannot read more into the jury's verdict than is expressly stated in that verdict, and it cannot divine the actual underlying bases for the jury's decision any more than Diamond, the Federal Circuit, or even this Court can. Its self-serving statements that the jurors never considered whether the patent disclosed an invention that involved lifting off a moving conveyor or a method where the three steps could occur simultaneously, and that "there is no possibility that the [the jury] looked at the disclosure with a method such as that used in the Omnia in mind when it reached its verdicts on written description and enablement," (Pet. at 11), must therefore be rejected, particularly since FPS cannot point to any instruction by the district court that would bring about such a result.

---

2. Although put on notice by both the district court's order itself, and Diamond's arguments with respect to the court's claim construction order, FPS chose, at its own peril, to argue a position with respect to the claim limitations of claim 24 that were not consistent with the order issued by the court to the parties and the jury. Any resulting error, therefore, if any such error is deemed to have occurred, was based solely on erroneous arguments made by Petitioners' counsel during trial, urging the jury to adopt claim interpretations contrary to the court's *Markman* order.

In arguing that the jury never reached the validity issues, FPS attempts to tie the jury's validity findings to its non-infringement findings. As support, FPS points to its own counsel's statements to the jury that validity should only be considered if the patent is held to be infringed, and argues that the jury's non-infringement findings necessarily mean that the jury never reached the question of validity. FPS is wrong. Petitioners' counsel's statements to the jury notwithstanding, the special verdict form that the jury was given — a form to which FPS did not object — did not link the jury's validity findings with the infringement findings in the manner advocated by FPS. While certain other questions posed to the jury (such as willfulness) were conditioned upon the jury's infringement findings, the verdict form and the court's instructions to the jury did not require such conditional deliberations with respect to validity. FPS's hypothesis with respect to what the jury might have done is further belied by the fact that the validity questions appear first in the verdict form, and that the validity and infringement questions with respect to claim 24 appeared in entirely separate sections of the verdict form. Specifically, with respect to the validity issues in question, the verdict form simply stated:

> Has FPS proven by clear and convincing evidence that claim 24 of the '505 patent is invalid for lack of enablement or inadequate written description?
>
> Has FPS proven by clear and convincing evidence that claim 24 of the '505 patent is anticipated by the Moba Type 5-9 machines or the Moba Type 68 machines?

The verdict form then went on to ask, with respect to infringement:

> Has Diamond proven by a preponderance of the evidence that the Omnia literally has all of the elements of claim 24 of the '505 patent?

On February 25, 2000, the jury rendered its verdict that none of the asserted claims (including claim 24 of the '505 patent) are invalid, and that FPS has not directly infringed or induced infringement of those claims through its activities involving the Omnia and Selecta machines. The court entered judgment for FPS based on this verdict on March 7, 2000.

3. Post-Trial Motions and Diamond's Appeal of the District Court's Denial of Its JMOL Motion

After the verdict, Diamond renewed its motion for JMOL, asking the district court to set aside the jury's verdict that claim 24 of the '505 patent is not infringed by the Omnia. Diamond argued that the claim interpretations that FPS advanced at trial were erroneous — and had already been rejected by the court — and that the jury verdict of non-infringement was thus not supported by substantial evidence. The district court summarily denied Diamond's JMOL motion and entered its final judgment on October 2, 2000. In its opinion, the court merely stated that it had not considered FPS's new claim interpretation theories with respect to "guiding steps" during the *Markman* proceedings. Although the court did not specifically address the merits of the claim interpretation arguments raised by Diamond, it expressly confirmed that the jury verdict was consistent with its own interpretation. In this manner, the court essentially

reversed its earlier correct claim interpretation rulings, which the jury had received, and instead adopted FPS's erroneous interpretation of the claim at issue.

In its appeal to the Federal Circuit, Diamond explained that the district court had misapplied its earlier claim interpretation ruling in denying Diamond's JMOL motion with respect to the '505 patent. The only evidence that FPS presented at trial to show that the asserted claim was not infringed by the accused Omnia machines was based on FPS's erroneous interpretation of the claim, which was only adopted by the district court post-verdict. In contrast, Diamond presented substantial evidence that those claims were infringed based on the proper interpretation of the claims. Consequently, the only evidence in the record on the infringement issues which a reasonable jury could consider was Diamond's evidence showing infringement, and no reasonable jury could have found that the asserted claims were not infringed. Although FPS cross-appealed for a remand on validity issues in case the jury's non-infringement findings were reversed, FPS made no attempt at the Federal Circuit level to show why it would be entitled to a new trial on validity issues that had already been tried and decided when those findings were not challenged by FPS below.[3]

4. The Federal Circuit's Decision

The Court of Appeals for the Federal Circuit agreed with Diamond's position on appeal with respect to claim 24 of

3. A party that does not move for JMOL before the case is submitted to the jury cannot on appeal challenge the sufficiency of the evidence underlying presumed jury findings, but is instead limited to challenging the judgment on the ground that the trial court committed an error of law or abused its discretion. *Union Carbide Chems. & Plastics Tech. v. Shell Oil Co.*, 308 F.3d 1167, 1177 (Fed. Cir. 2002) (citations omitted).

the '505 patent, and held that "[b]ecause no reasonable jury could find on the record evidence that the method performed by the Moba Omnia does not infringe literally and directly claim 24 of the '505 patent, the district court erred in not granting JMOL on that issue." (Pet. App. 14a.) In reviewing the record, the Federal Circuit expressly recognized that the claim construction given by the court to the jury was broader than that adopted by the district court post-verdict when it denied Diamond's JMOL motion, and that the district court's original claim construction — which was given to the jury — was correct:

> Diamond has argued consistently, in its JMOL motions and in its argument on appeal here, that "[n]either the language of the claim itself not the Court's order defining this language requires that the 'guiding steps' occur separately." . . . [T]his court will not apply waiver to prevent Diamond from ***protecting the original breadth of the binding claim construction presented by the district court to the jury*** from post facto imposition of an additional limitation. . . . ***[T]his court, like the district court as well, construes the guiding steps to include simultaneous performance.***

(Pet. App. 11a) (emphasis added). Similarly, the court held that the district court correctly construed the "holding station" limitation of claim 24 of the '505 patent in its original *Markman* order, and that "[i]n view of the undisputed record evidence, no reasonable jury could find that the Moba Omnia does not move an egg to a holding station as claimed." (Pet. App. 14a.) In doing so, the Federal Circuit essentially found that the jury had misapplied the facts in the record to

the correct claim interpretation that it had been given in rendering its non-infringement verdict. Thus, FPS is incorrect both when it states that the Federal Circuit changed claim construction on appeal in this case, and when it states that "the Federal Circuit interpreted the claim more broadly than the claim interpretation that the district court had permitted the jury to use in finding non-infringement." (Pet. at. 8.) Quite the contrary, the Federal Circuit actually enforced the district court's original claim construction order, which was appropriately given to the jury.

Because it cannot allege error on the part of the district court in claim construction, FPS also argues, at footnote 8 on page 8 of its petition, that "regardless of the origin of the error," the jury used a narrower claim than that deemed correct on appeal. In this manner, FPS attempts to gloss over the fact that any alleged error resulted from its own erroneous arguments — not the district court's or Diamond's — and thus cannot form the basis for a new trial.

REASONS FOR DENYING THE PETITION

A. The Decision Below Does Not Create a Conflict Warranting Certiorari

This garden-variety patent infringement case does not warrant certiorari review by this Court. This case does not present any issues involving a split in authority among the circuits (or within the Federal Circuit) in terms of the applicable law, nor does it present a conflict with Supreme Court precedent. Rather, the Federal Circuit correctly applied clearly established standards of review that it uniformly applies when it upheld the jury's verdict with respect to the validity issues in this case.

FPS attempts to portray this case as one in which the Federal Circuit changed the claim interpretation on appeal, and urges this Court to grant a writ of certiorari "to instruct the Federal Circuit on the standard it must apply" after such a change in claim interpretation. FPS incorrectly argues that the Federal Circuit's decision (1) deprived FPS of its right to a jury trial with respect to patent validity based on a changed claim interpretation, and (2) is contrary to established law that a new trial must be granted if an erroneous instruction is deemed to be prejudicial error.

FPS's premise is fundamentally flawed because, as described above, the Federal Circuit did not change but rather affirmed the interpretation of claim 24 of the '505 patent on appeal. Thus, FPS has already had the trial with respect to the validity of claim 24 based on the proper claim interpretation that it allegedly seeks, making this case a singularly inappropriate vehicle for consideration of the question presented by Petitioners. Petitioners' erroneous instruction arguments are similarly unavailing, because FPS cannot point to a single erroneous jury instruction given to the jury that would necessitate a new trial.

1. The Federal Circuit Did Not Alter the Claim Interpretation on Appeal and Consequently its Decision Cannot in Any Way Be Characterized as Impacting Petitioners' Right to a Jury Trial

The falsity of FPS's assertion that the Federal Circuit broadened claim construction on appeal undermines all of Petitioners' arguments. Not a single case that FPS cites in its petition requires or even contemplates remand for a determination of validity when the appellate court has actually upheld the claim interpretation provided by the

district court to the jury. *See, e.g.*, *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332 (Fed. Cir. 2003) (incorrect claim construction given to the jury); *Ecolab Inc. v. Paraclipse, Inc.*, 285 F.3d 1362 (Fed. Cir. 2002) (incorrect claim construction given to the jury); *LaPorte Pigments, Inc. v. Axel J., LP*, 2002 WL 1890749 (Fed. Cir. Aug. 15, 2002) (incorrect claim construction given to the jury); *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002) (incorrect claim construction given to the jury); *Union Carbide Chems. & Plastics Tech. v. Shell Oil Co.*, 308 F.3d 1167 (Fed. Cir. 2002) (incorrect claim construction given to the jury); *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339 (Fed. Cir. 2003) (district court erred in claim construction); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002) (incorrect claim construction given to the jury); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (incorrect claim construction given to the jury); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340 (Fed. Cir. 1998) (district court did not construe the disputed claim terms).

Here, FPS's arguments are particularly egregious because, to the extent that any error was injected into the proceedings or into the jury's findings, it was precipitated by FPS's own conduct in urging the jury to adopt a claim interpretation inconsistent with that set forth by the district court. *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 715 (Fed. Cir. 1998) ("Ordinarily, doctrines of estoppel, waiver, invited error, or the like would prohibit a party from asserting as 'error' a position that it had advocated at the trial.")

FPS's arguments that the Federal Circuit's interpretation of the claim differed from that used by the jury, and that the

Federal Circuit's claim construction somehow took away from the jury the opportunity to consider the validity of the claim in light of the broader legal meaning is frivolous. First, the jury received the appropriate jury instruction, and was not free to override the district court's construction of the dispute terms, which were upheld on appeal. Second, it was FPS's trial strategy to ignore the possibility that Diamond would likely prevail on the contested issues of claim construction. Both parties entered the case armed with the district court's order, and FPS chose not to present any evidence to support its validity case in the event that the construction set forth by the district court and advocated by Diamond were adopted on appeal. In other words, FPS chose to try its case assuming, despite all evidence to the contrary, that it would prevail on its asserted claim construction. FPS cannot be allowed a proverbial second bite at the apple now that the claim construction issue has been resolved consistently with the instructions given to the jury by the district court and the positions taken by Diamond.

2. FPS Has Not Identified Any Errors in the Jury Instructions Warranting a New Trial

In its petition, FPS cites *Ecolab Inc. v. Paraclipse, Inc.*, 285 F.3d 1362, 1373-76 (Fed. Cir. 2002) for the proposition that "when the Federal Circuit changes a claim interpretation on appeal, it must consider whether the error in claim construction was harmless or prejudicial." (Pet. at 2.) *Ecolab* involved the appeal of an erroneous instruction regarding claim construction that may have affected the jury's decision on infringement. In that case, the *Ecolab* court held that "a party seeking to alter a judgment based on erroneous jury instructions must establish that those instructions were legally erroneous and that those instructions had prejudicial effect."

Ecolab, 285 F.3d at 1373-74 (holding that if the procedural error with respect to an incorrect jury instruction was "harmless," a new trial "would be mere waste and affirmance of the judgment is required.") The *Ecolab* case has no bearing on a case where there is no error with respect to jury instructions on claim interpretation.

Moreover, notwithstanding the fact that no change in claim construction took place here, it should be noted that the mere fact that a new claim construction has been adopted on appeal would normally be insufficient, in and of itself, to require a new trial. The burden is on the party seeking a new trial to show some error in the way the trial was conducted and to demonstrate that the error was prejudicial.[4] In asking the Federal Circuit for a new trial on validity issues, FPS had the burden to demonstrate both error and prejudice. FPS does not and cannot point to any errors of law and cannot make the requisite showing of prejudice.

B. The Federal Circuit Applied The Correct Standard of Review With Respect to Both The Infringement And The Validity Issues

FPS urges this Court to accept its petition to instruct the Federal Circuit on the standard it must apply when it changes claim construction, and goes on to cite various claim interpretation change statistics to transform its petition into one meriting the exercise of this Court's discretionary review.

---

4. "We may affirm the jury's findings on infringement of validity issues if substantial evidence appears in the record supporting the jury's verdict and if correction of the errors in a jury instruction on claim construction would not have changed the result, given the evidence presented." *Teleflex*, 299 F.3d at 1328 (citations omitted).

As previously stated, however, this case did not involve any change in claim construction. The standards that the Federal Circuit did apply, given the procedural posture of the case before it, have been consistently and correctly applied, in accordance with the Federal Circuit's long-standing practices, and do not present any conflict or other appropriate issue for this Court's consideration.

The Federal Circuit has well-established standards of review that it uniformly applies in reviewing a district court's decision to grant or deny a motion for JMOL. *See, e.g.*, *Eaton*, 323 F.3d at 1336

> We review *de novo* a district court's decision to grant or deny a motion for judgment as a matter of law ("JMOL") by reapplying the JMOL standard. This court will reverse a denial of JMOL only "if the jury's factual findings are not supported by substantial evidence or if the legal conclusions implied from the jury's verdict cannot in law be supported by those findings."

(citations omitted).

Determination of patent infringement is a question of fact, which, in the context of a jury trial, the Federal Circuit reviews for substantial evidence. *Union Carbide*, 308 F.3d at 1167. In this case, with respect to the jury's finding of non-infringement of claim 24 of the '505 patent, and the district court's denial of Diamond's JMOL on that issue, the district court applied this well-established standard and appropriately found that the jury verdict was not supported by substantial evidence based on the proper claim interpretation which had been given to the jury.

The Federal Circuit has also addressed the appropriate standard for reviewing a jury verdict concerning validity determinations of anticipation, written description, and enablement. *Door-Master Corp. v. Yorktowne, Inc.*, 256 F.3d 1308 (Fed. Cir. 2001) ("Where . . . a jury finds a patent valid, this court will not disturb that finding unless reasonable jurors could not have reached that verdict.") The Federal Circuit has consistently held that such jury findings are reviewed for substantial evidence. *See, e.g.*, *Teleflex*, 299 F.3d at 1323 ("What a prior art reference discloses in an anticipation analysis is a factual determination that we review for substantial evidence when decided by a jury."); *PIN/NIP, Inc. v. Platte Chem. Co.*, 304 F.3d 1235 (Fed. Cir. 2002) ("A determination that a patent is invalid for failure to meet the written description requirement . . . is a question of fact . . . and we review a jury's determination of facts relating to compliance with the written description requirement for substantial evidence."); *Mitsubishi Elec. Corp. v. Ampex Corp.*, 190 F.3d 1300, 1309 (Fed. Cir. 1999) (a jury's underlying factual determinations related to enablement are reviewed for substantial evidence). With respect to the validity findings, the Federal Circuit again correctly followed its long-standing and undisputed standards in reviewing decisions, and reached the correct conclusion that the jury's validity findings were all supported by substantial evidence.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

ALBERT J. BRENEISEN
Counsel of Record
JOHN W. BATEMAN
SHEILA MORTAZAVI
KENYON & KENYON
Attorneys for Respondent
One Broadway
New York, NY 10004
(212) 425-7200